

REMARKS/ARGUMENTS

Claims 1-42 were pending in this application. No claims have been amended, added or canceled. Hence, claims 1-42 remain pending. Reconsideration of the subject application as amended is respectfully requested.

Claims 1-26, 30-34, 37-39 and 42, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over cited portions of U.S. Patent No. 6,230,017 to Andersson, *et al.*, (hereinafter "Andersson"), and further in view of the cited portions of U.S. Patent No. 6,148,197 to Bridges, *et al.* (hereinafter "Bridges").

Claims 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson, in view of Bridges, and further in view of the cited portions of U.S. Patent No. 6,397,040 to Titmus, *et al.* (hereinafter "Titmus").

Claims 28-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson, in view of Bridges, and further in view of the cited portions of U.S. Patent No. 6,522,888 to Garceran, *et al.* (hereinafter "Garceran").

Claims 35-36, and 40-41, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson, in view of Bridges, and further in view of the cited portions of U.S. Patent No. 6,212,377 to Dufour, *et al.* (hereinafter "Dufour").

Claim Rejections Under 35 U.S.C. § 103(a)

As to claim 1, the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action has not shown that the prior art teaches or suggests all the claim limitations, the office action does not cite a reference that teaches or suggests a motivation to combine reference teachings, and the combined references would not result in a working embodiment of the Applicant's claimed invention.

For example, with respect to the requirement that the prior art references must teach or suggest all claim limitations, the office action correctly states that "Andersson et al. fail to disclose receiving from the mobile subscriber user-defined associated with at least one telephone service subscribed to by the mobile subscriber." The Applicants take this to mean that Andersson fails to teach the claim 1 limitation, "receiving from the mobile subscriber user-defined, location-dependent rules associated with at least one telephone service subscribed to by the mobile subscriber," which is true. The office action, however, goes on to assert that this may be found in Bridges. With this assertion, the Applicants respectfully disagree.

Bridges teaches a system whereby a cellular service provider establishes agreements with other service providers into whose areas a customer may roam. The service provider then establishes an order of priority that determines whose systems their customers should use when roaming. The information is periodically downloaded to their customers' mobile units. Nowhere does Bridges teach that the user establishes the roaming rules. Thus, the prior art does not teach this limitation and claim 1 is believed to be allowable for at least this reason.

Second, the office action does not cite a reference in the prior art that provides the necessary motivation or suggestion to combine the teachings of Andersson with those of Bridges to achieve the Applicant's claimed invention. The Applicants note that,

[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly

or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(MPEP § 2143.01) However,

[t]he examiner may take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being well-known in the art. ... If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. ... If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts **must be supported, when called for by the applicant, by an affidavit** from the examiner.

(MPEP § 2144.03, emphasis added) Because no reference is cited that provides the teaching, suggestion, or motivation to combine the references, the Applicants assume the office action is relying on facts within the personal knowledge of the Examiner. The Applicants, therefore, respectfully traverse the rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by 37 CFR § 1.104(d)(2). Claim 1 is, therefore, believed to be allowable for this additional reason.

Finally, because Bridges and Andersson fail to teach all the limitations of claim 1, there is no reasonable expectation of success that the two, when combined, will result in a working example of the Applicant's claimed invention. Thus, Claim 1 is believed to be allowable for this additional reason.

Claim 17 includes similar limitations and is, therefore, believed to be allowable, at least for the reasons stated above with respect to claim 1.

Claims 2-16 and 18-42 each depend either directly or indirectly from claim 1 or claim 17. These claims, therefore, are believed to be allowable, at least for the reasons stated above.

Further, however, the Applicants note that in the rejections of a number of the dependent claims, the office action combines references. In no case does the office

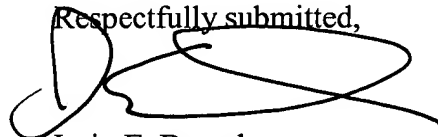
Application No.: 09/444,359
Amendment dated July 7, 2003
Reply to Office Action of April 7, 2003
Page 12

PATENT

action cite a reference that teaches or suggests a motivation to combine the references as suggested by the office action. Thus, the Applicants assume that the office action is relying on facts within the personal knowledge of the examiner in each instance. In each case, therefore, the Applicants respectfully traverse the rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by 37 CFR § 1.104(d)(2).

In light of the foregoing, the Applicants believe all claims now pending are in condition for allowance and respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
IEB:arl
DE 7102167 v1